

**REMARKS**

**I. Summary**

A final Office Action, dated May 5, 2004, and an Advisory Action, dated November 19, 2004 are outstanding.

Claims 1, 3, 6, 8, 9, 11 and 14-31 are pending in the application. The claims stand rejected as discussed in Applicant's last Reply, the entry of which is requested.

**II. Discussion**

The Examiner's reasons set forth in the Advisory Action are addressed with specificity below with reference to rejections presented in the final Office Action.

**Points A and F**

Regarding point a), the Examiner has noted that Applicants have argued with specificity that certain features are not shown in art cited as the grounds for a Section 103 obviousness rejection. The Examiner has stated that one cannot show nonobviousness by attacking referenced individually where the rejections are based on combinations of references.

A Section 103 rejection is proper only if all claim limitations are taught or suggested by the prior art. MPEP §2143.03. Applicant has disputed that a particular recitation of the claim is shown in certain art, and has not merely attacked the references individually. For example, if the claim is for a combination of A and B, and the 103 rejection is that reference 1 shows A, reference 2 shows B and that there is motivation to combine the references, Applicant has argued that reference 1 does not show A as asserted by the Examiner, and therefore references 1 and 2 in

**Reply to final Office Action dated May 5, 2004**

combination do not teach or suggest all claim limitations, and thus that the rejection should be withdrawn, as discussed below with reference to claims 1, 3, 6,8, 9, 11 and 14.

Regarding point f), the Examiner asserts that the claims do not recite that the display area does not change in size as argued by Applicants. Applicants respectfully disagree. The claims as presently written do require that the display area does not change in size. Referring to claim 1, it is noted that the express language of the claim recites that the display area is of "a certain size" before resizing the slider, and that after resizing of the slider, the display area is of "said certain size". Thus, there is only one single size of the display area; the display area remains the same size, and does not change in size, when the slider is resized. It is believed that clarification of the claims in this regard is unnecessary.

**Claims 1, 3, 6,8, 9, 11 and 14**

In emphasis of the point above, it is argued here that none of the cited art, alone or in combination, teaches or suggests the method of claim 1, and particularly "providing a display area of a certain size via the graphical user interface, said display area being provided adjacent said image", "displaying a slider . . . to define a corresponding first portion of said image within a boundary of said slider", "displaying said first portion of said image in said display area, said first portion of said image being enlarged relative to said image to fill said display area of said certain size", "accepting user input to resize said slider", "displaying said slider as resized . . . to define a corresponding second portion of said image within said boundary of said slider" and "displaying said second portion of said image in said

display area, said portion of said image being enlarged relative to said image to fill said display area of said certain size."

For example, this means that a slider may show a small portion of an image that is enlarged to fill a display area that is 2 inches by 3 inches in size. This may be a zoom factor of 5x. Further, this means that when the slider is resized to show an even smaller portion, that smaller portion is enlarged to fill a display area that is of the same exact size, namely 2 inches by 3 inches in size in this example. This may involve a zoom factor of 10x. Accordingly, no matter the size of the portion selected for viewing enlarged, the portion is always displayed in a display area having a certain size that does not vary with the size of the portion selected for viewing. This is neither taught nor suggested by any of the cited art.

To assist the Examiner in comparing these recitations to the cited art, which arguably requires more than the usual amount of careful reading before it is readily understood, it is noted that the thumbnail window disclosed by Rowe shows in a first page only a reduced scale image of a portion of a second page, and has no relation to a slider or selected image portion. Further, the zoom function of Warnock has no relation to a slider, as in Applicants' claims, and in any event discloses only that an item may be enlarged, but not that any selected portion of any scope may be enlarged to fit in a display window of a size that is fixed no matter the scope of the portion selected for enlarged viewing.

With respect to Paal, which may incorrectly appear at first blush to be similar to the claimed invention, it is noted that Paal discloses a computer program that provides for display of window regions on a display screen whereby the content and size of one window region (an active window) is controllable in two dimensions using means provided in another window region (a scroll palette). See Figs. 2 and 4.

More specifically, a scroll palette and an active window are provided such that the active window displays to the user a portion of the information available for display, which portion is selected using the scroll palette. However, as the view area of the scroll palette is reduced in size, the active window is also reduced in size in an equivalent manner and the view area outline becomes visible as shown in Figs. 5 and 6. See Paal, col. 7, lines 41-44; equations in Fig. 10. This is directly contrary to the claimed invention which requires that the display area remain a fixed size despite changes in scope of the selected area.

For at least these reasons, the cited art, taken alone or in combination, fails to teach or suggest all claim limitations. Reconsideration and withdrawal of the rejections of claims 1, 3, 6, 8, 9, 11 and 14.

### **Point B**

Regarding point b) of the Advisory Action, the Examiner has acknowledged the need for motivation, and is asserting that the motivation to combine with respect to the rejections of the final Office Action is that "all of the cited references teach a method of viewing documents." The assertion that the cited references relate generally to the field of viewing documents is not a sufficient showing of motivation. As clearly stated in the MPEP, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" MPEP 2143. Applicants' assert that the prior art does not do so.

As discussed at length in Applicants' last Reply, the U.S. Court of Appeals for the Federal Circuit has considered the issue of finding motivation and stated that a finding of motivation "must be based on objective evidence of record" and that:

[an] Examiner's conclusory statements . . . do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang-Su Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Further, the Federal Circuit clarified that conclusory statements asserting motivation that are based on "common knowledge and common sense" are not sufficient to fulfill the Board's obligation to develop an evidentiary basis for its findings. *Id.* There is no objective evidence of record, particularly in Paal, Rowe, Warnock and/or Moran (and particularly for the four-way combination of art forming the basis for the obviousness rejection of claims 8 and 9), providing the asserted motivation.

For at least these additional reasons, reconsideration and withdrawal of the rejections of claims 1, 3, 6, 8, 9 and 14 are requested respectfully.

### **Points C and D**

Regarding points c) and d) of the Advisory Action, the Examiner has adopted the position of the final Office Action with respect to claims 11, 18-20, 25-28 and 31, stating that "Paal teaches the use of sliding vertically and horizontally as well as being able to scroll only in a single direction by constraining one of the sliding directions. Therefore, there exist two different sliders, one for horizontal sliding and one for vertically." Applicants respectfully disagree as set forth below in the discussion of claims 11, 18-20, 25-28 and 31.

### **Claims 11, 18-20, 25-28 and 31**

Claim 11 depends from claim 1 and is likewise believed patentable. Further,

claim 11 expressly requires a second slider in addition to the first slider, both of which are superimposed over an image. Claim 11 is amended herein to clarify that there are two distinct sliders. See sliders 340, 360, Figure 3. These two distinct sliders together define a selected portion of an image at their intersection.

In contrast, Paal discloses only a single view/scroll area, which can be moved horizontally or vertically. The singular nature of this area is readily apparent from the Figures in Paal, such as Figure 4. Although the area of Paal may slide horizontally or vertically, Paal simply provides no teaching or suggestion whatsoever of two distinct sliders.

In emphasis of the contrast between the singular nature of the area disclosed in Paal and the two distinct sliders claimed, it is noted that in Paal, all of the image is within the outline of the area. In contrast, with two distinct sliders, there is a portion of the image bounded by the first slider that is not bounded by the second slider, and/or there is a portion of the image bounded by the second slider that is not bounded by the first slider. This arrangement is characteristic of having two distinct sliders and emphasizes that Paal discloses merely a single area, and not two distinct sliders.

Further, Paal fails to provide any teaching or suggestion of first and second sliders that intersect to define a selected portion of an image, as recited in claim 11.

Further, neither Rowe nor Warnock teach or suggest two distinct, intersecting sliders. Accordingly, the cited art, taken alone or in combination, fails to teach or suggest the claimed invention.

Claims 25-28 and 31 depend from claim 11 and are likewise patentable. In addition, claim 25 requires that the first slider is translatable relative to an image along only one axis. Similarly, claim 26 requires that the first slider is resizable along

only one axis. This is clearly distinct from the cited art, particularly Paal, which discloses a single view area that is translatable and resizable both horizontally and vertically. Claims 27 and 28 include similar recitations with respect to a second slider.

Further, claim 31 recites that there are both a first slider that is translatable and resizable only along a first axis, and a second slider that is translatable and resizable only along a second axis orthogonal to the first axis. This is neither taught nor suggested by Paal. At most, Paal discloses a single scroll area that is translatable and resizable both horizontally and vertically, and that may be operated in a certain mode to scroll in a single direction only. See Action, page 7; Paal, col. 11, lines 52-68 and col. 12, lines 1-3. However, there is no disclosure whatsoever of two separate, specially configured sliders, each capable of translation/resizing in a one of two orthogonal directions.

Claims 18-20 are patentable for at least similar reasons.

For at least these reasons, reconsideration and withdrawal of the rejections of claims 11, 18-20, 25-28 and 31 are requested respectfully.

#### **Point E**

Regarding point e) of the Advisory Action, the Examiner has asserted that Paal teaches a second portion adjacent to the image, citing Paal, Fig. 10; col. 5, lines 5-40. Applicant respectfully disagrees, as discussed below with reference to claims 15-17, 29 and 30.

#### **Claims 15-17, 29 and 30**

Claim 15 is believed patentable for reasons similar to those set forth above.

Amended claim 16 recites that the slider (see slider 340, Figure 3) includes not only a first portion that is superimposed and translatable over an image (see portion of slider 340 other than grab bar 342, Figure 3). In a certain respect, this is similar to the active window disclosed in Paal. However, claim 16 recites that the slider also includes a second portion (see grab bar 342, Figure 3) that is positioned outside of and adjacent to the image (the image being image of the graph in overview window 310 in Figure 3). Contrary to the resizable window of Paal, which may be moved only within the area selectable for viewing, the claimed slider includes a portion that is positioned outside of and adjacent to the image (i.e., not superimposed over the image). This is neither taught nor suggested by any of the cited art, and in particular, is neither taught nor suggested by Paal.

For at least these additional reasons, reconsideration and withdrawal of the rejections of claims 15-17, 29 and 30 are requested respectfully.

### **Claims 21-24**

Independent claims 21 and 23 are directed to a system and computer program product for displaying a user-selected portion of an image. The system/product displays portions of an image selected by a resizable slider. Regardless of the size of the selected portion, the selected portion is displayed in a display area of a certain fixed size. Accordingly, any resizing of that slider, and corresponding resizing of a selected portion of that image, results in display of the resized portion in a display area that does not change in size. Accordingly, the selected portion is scaled accordingly for display in the display area of a fixed size. This is neither taught nor suggested by the cited art, as discussed above with reference to claim 1.

Further, the claim recites that any selected portion (as determined by the slider) may be displayed in the display area; in contrast, Warnock discloses only that a certain predefined portion (e.g. the article text) may be displayed. In any event, there is no motivation in the objective evidence of record (see above) to combine the teachings of Paal and Warnock.

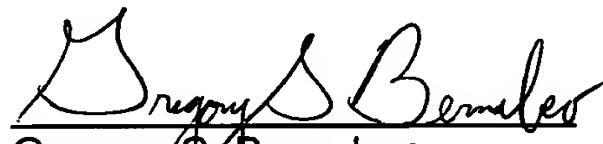
For at least these reasons, reconsideration and withdrawal of the rejections of claims 21-24 are requested respectfully.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants believe claims 1, 3, 6, 8, 9, 11 and 14-31 to be patentable and the application in condition for allowance. Applicants respectfully request issuance of a Notice of Allowance. If any issues remain, the undersigned requests a telephone interview prior to the issuance of an action.

Respectfully submitted,

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